



The Examiner's argument, as apparent from the statements on page 4 of the Answer, that the claims are generally vague and unclear is a bare conclusion, unspecific, and without any relation to the definiteness standard under 35 U.S.C. 112, second paragraph. The Examiner mistakes functional language in the Appellant's apparatus claims to method limitations. Claim features of an apparatus may be recited using functional language (MPEP §2114), and use of functional language in a claim does not, in and as of itself, render the claim improper (MPEP §2173.05g).

On page 8, the Examiner states that Appellant argued that EP applications are allowed to use various terms. The Examiner appears to misconstrue the Appellant's argument. Appellant, stating on page 5 of its Brief, that the "[claim 1] language [is hereby characterized] is commonly used in claims written for EP applications, such as the priority document" is not arguing that the rules of the EP Patent Office apply instead of the USPTO rules to the examination of the US application. Rather, the Applicant is merely explaining the reason why the claim language is in the presented form (i.e. the US application being a translation of the foreign priority application, that used language in a specific form to meet the requirements of a foreign (EP) patent office), and noting that though this language which appears thus in the claims of the US application by virtue of translation, is not indefinite under 35 U.S.C. 112, second paragraph. In view of the effect the U.S. Supreme Court decision in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., gives the scope of protection afforded by amended claims, claim amendments are made only if clearly necessary. Such is not the case with the claim language rejected as indefinite by the

Examiner under 35 U.S.C. 112, second paragraph in the instant application. The amendments sought by the Examiner are merely to satisfy the Examiner's preference, and in view of Festo such amendments can not be made.

The Examiner's statement on page 9 regarding claim 1, "that anything can be detached with... even a hacksaw" belies the Examiner's argument that Foulke discloses an interface having a mechanical and electrical part forming a detachable mounting of the functional unit, as otherwise recited in the claim. Indeed, Foulke does disclose pod openers (32a-32b) having mechanical parts and electrical parts that interface storage system housing (12), but if those parts are to be cut with a hacksaw in order to detach the pod openers from the housing, then they do not form a detachable mounting as would be understood by anyone skilled in the art. Foulke is absolutely silent with respect to detachment of any functional unit, and does not disclose all the features recited in claim 1, and hence, does not anticipate claim 1.


The Examiner's statement on page 11, regarding the term "selectable" in claim 9 is revealing in that, the Examiner appears to have formed, and continues to posit the argument that claim 9 is anticipated by Foulke, without apparently having read the entire claim language. The Appellant, has argued to the Examiner (during prosecution) and in the Appeal Brief, that claim 9 does not merely recite that the at least one module is selectable without more, but rather that claim 9 recites that the at least one module is selectable for connection to the housing from a number of different interchangeable modules each having a different predetermined characteristic. There is nothing whatsoever in Foulke that discloses or suggests (either by mere computation action, by control program, or anything else) a

module that is selectable for connection to the housing from a number of different interchangeable modules each having a different predetermined characteristic, as otherwise called for in claim 9.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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11/23/01  
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